

REMARKS

Claims 1 – 17 are in this Application. Applicants have amended claim 1 to clarify claim scope. Claims 15 - 17 are added from the parent of this application. No new matter has been added. In the Office Action mailed on December 5, 2000, the Examiner rejected Claims 1-3, 6, 8, 9, and 11-13 under 35 U.S.C. §103(a) as allegedly being unpatentable over *Spartz* et al. (5,878,036) in view of *Bolon* et al. (5,822,420). The Examiner rejected Claims 4-5, 7, 10, and 14 under 35 U.S.C. §103(a) as allegedly being unpatentable over *Spartz* in view of *Bolon* as applied to claims 1, 6, and 11, and further in view of *Baldwin* et al. (5,633,868). The Applicant respectfully traverses the Examiner's rejections.

35 U.S.C. §103(a): *Spartz* and *Bolon*

The Applicants respectfully submit that neither *Spartz* nor *Bolon* teach features of overcoming deficiencies present in the IS-634 Mobile Switching Center – Base Station Compatibility Standard for Dual Mode Wideband Spread Spectrum Cellular Systems, as is found in independent claims 1, 6, and 11. Applicants' independent claims 1, 6, and 11 overcome conditions in cellular communications whereby a mobile subscriber attempts to originate a call while another party is attempting to call the same mobile subscriber. *Spartz* teaches a method and apparatus for combining a CDMA system with a GSM system to reduce the cost of providing superior CDMA service in a region already unwisely invested in GSM infrastructure. *Bolon* teaches a protocol for Digital Loop Carriers unrelated to IS-634, and in fact, teaches away from the Applicants' claimed features by describing protocols relating to North American standard 1.544 Mbps T1 communications and CCITT standard 2.048 Mbps E1 communications, as well as TR-303 and the European Telecommunications Standard Institute V5 standards describing interfaces for remote digital terminals and local digital switches. The Examiner states, "The motivation/suggestion would have been to notify the end points and correct the procedure for establishing a telephone call in a communication system." Applicants

respectfully submit that there is no teaching, suggestion, or incentive in either *Spartz* or *Bolon* supporting the combination as the communication systems and the endpoints are not related. Applicants respectfully submit that the suggestion to combine the references would be motivated by hindsight. Combining *Spartz* with *Bolon* would destroy the utility of both systems by producing a hybrid cellular CDMA/GSM system with remote digital terminal and local digital switches as endpoints. Applicants respectfully submit that the Examiner has not provided a proper *prima facie* case of obviousness because there is no motivation or teaching to combine these references in a manner that would render Claims 1-3, 6, 8, 9, and 11-13 unpatentable, the combination teaches away from the claimed invention, the utility of the combination would be destroyed, and the references were chosen using hindsight in an attempt to re-create the claimed subject matter.

35 U.S.C. §103(a): *Spartz* and *Bolon* in view of *Baldwin*

The Examiner states that *Baldwin* discloses transmitting Alert With Information Message Signals between a wireless gateway and a subsystem of a CDMA wireless network. Hence, the Examiner concludes that *Spartz* and *Bolon* in view of *Baldwin* render Claims 4 – 5, 7, 10, and 14 unpatentable. Applicants respectfully disagree.

Applicants respectfully submit that there is no suggestion or teaching to combine *Baldwin* with either *Spartz* or *Bolon* because *Baldwin* addresses an Alert With Information Message on an Air Interface, not Mobile Switching Center – Base Station communications, and that such messages on the Air Interface are well known.

Because neither *Spartz* nor *Bolon* mentions or suggests the use of Alert With Information Signals, and *Baldwin* does not teach or suggest IS-634 communications, Applicants respectfully submit there is no motivation or teaching to combine these references in a manner that would render Claims 4 – 5, 7, 10, and 14 unpatentable.

CONCLUSION

In light of the amendments and arguments presented in this Response, Applicants respectfully submit that the Application is in condition for allowance, for which early action is requested.

Respectfully submitted,

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